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10/727,663	12/05/2003	Hiroyuki Shibaki	246242US2	4974
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
KAU, STEVEN Y				
ART UNIT		PAPER NUMBER		
2625				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/727,663

Applicant(s)

SHIBAKI ET AL.

Examiner

STEVEN KAU

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 28-53 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 28-51 and 60-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 52, 53, 66 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/29/2008, and has been entered and made of record. Claims 1-19, 28-51 and 60-65 have been withdrawn as directed to non-elected claims. Claims 22-27 and 54-59 have been cancelled, and claims 66 & 67 are added. Currently, claims 20, 21, 52, 53, 66 and 67 are pending for further examination in this Action.

Response to Remark/Arguments

2. Applicant's arguments with respect to claims 20-21 and 52-53 have been fully and the reply to the Remarks/Arguments is in the following:

Applicant's arguments, "Claims 20-21 and 52-53 under 35 U.S.C. § 112, first paragraph", pages 21-22, Remarks, have been fully considered and are persuasive. Claims 20 and 52 have been amended. The rejection of 20-21 and 52-53 under 35 U.S.C. § 112, first paragraph is withdrawn.

Applicant's arguments, "Applicants note that the outstanding Office Action did not reject Claims 20-21 and 52-53 over any art references. The outstanding Office Action indicates on page 12 that a search of art was apparently not performed regarding the features of Claims 20-21 and

52-53,

despite the MPEP § 706.3(o) clearly requiring such a search. The MPEP states that "if new matter is added only to a claim ... **the new matter must be considered as part of the claimed subject matter and cannot be ignored.**"¹ As no rejection of Claim 20-21 and 52-53 over art references has been made, these claims are considered to be allowable, as the 35 U.S.C. § 112, first paragraph, rejection has been overcome." Page 22-23, Remarks.

In re, the examiner respectfully disagrees with the statement that "Applicants note that the outstanding Office Action did not reject Claims 20-21 and 52-53 over any art references. The outstanding Office Action indicates on page 12 that a search of art was apparently not performed regarding the features of Claims 20-21 and 52-53" because the applicant has made a wrong interpretation of "No prior arts were found due to new matter added into the amended claims 20 and 52". The examiner put a note on page 12 in the previous Action, which states that "**Claims 20-21 and 52-53 are rejected under 35 U.S.C. first paragraph due to new matter added. No prior arts were found due to new matter added into the amended claims 20 and 52. Further search and consideration are required upon receiving new claim amendment.**" "No prior arts were found" **does not mean** no search is performed, rather, it indicates that the examiner has searched the claim element based on what it is claimed in the amendment and "no prior arts were found" because of new matter was added into claims 20 and 52. Further, as stated on page 12 in the previous Action, the examiner

points out that "Further search and consideration are required upon receiving new claim amendment".

Applicant's arguments with respect to claims 20-21 and 52-53 have been fully considered but are moot in view of the new ground(s) of rejection due to amendments.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 52, 53 and 67 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, Claim 52 is directed to an image

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

processing method, steps recite, "inputting color image signals; and magnifying data of the color image signals input in such a manner that predetermined color information included in the data of the color image signals before magnifying the data of the color image signals are retained even after magnifying the data of the color image signals, wherein the magnifying step includes, separately magnifying data of a first component signal of the color image signals represented by a plurality of color component signals, and separately magnifying data of a second component signal of the color image signals, the second component signal being different from the first component signal, based on a ratio between the data of the first component signal of the color image signals and the data of the second component signal of the color image signals, and the magnified data of the first component signal magnified in the step of separately magnifying data of the first component signal." The applicant has not provided explicit and deliberate definitions of which particular apparatus is used for the image processing method, i.e. executing steps of "inputting color image signals", and "judging magnifying data of the color image signals", etc., or to limit the steps of "inputting color image signals", and "judging magnifying data of the color image signals", etc., for transforming underlying subject matter (such as an article or material) to a different state or thing. Thus, the image processing method would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine, i.e. a set of algorithm or a set of procedures without a machine for execution. Claims 53 and 67 are

dependent claims to claim 52, and are rejected under 35 U.S.C. 101 because of its dependency to claim 52.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20, 21, 52, 53, and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al (US 5,124,785) in view of Miyadera (US 5,619,260).

Regarding claim 20.

Claim 20 is an apparatus claim with multiple units, i.e. an input unit, and a magnification unit. Units cited in the claim indicate the structure of the claimed apparatus for intended use only because these claimed elements are not configured to function. An apparatus must be distinguished from the prior art in terms of structure rather than function. "Apparatus claims cover what a device is, not what a device does" (MPEP 2114). Claim 20 is rejected because the apparatus of claim 20 is not distinguishable from the prior arts cited in the following:

Hirose discloses an image processing apparatus (**i.e. image process system of Figs. 2 & 6**), comprising: an input unit (**i.e. image pickup device of Figs. 2 & 6**) that inputs color image signals (**i.e. RGB signals are processed, i.e. compression,**

gamma correction and amplification, etc., col 5, lines 34-62, First Embodiment; and col 8, lines 55-66, Second Embodiment); and a magnification unit (i.e. **amplifiers of 71R, 71G & 71B of Fig. 2 and 51R, 51G & 51B of Fig. 6**) that magnifies data of the color image signals input by the input unit, wherein the magnification unit includes, a first magnification unit (i.e. **amplifier 71G of Fig. 2 and 51G of Fig. 6**) that magnifies data of a first component signal (i.e. **G or green signal**) of the color image signals represented by a plurality of color component signals (i.e. **amplification data of G-signal of RGB components, Figs. 2 & 6, col 5, lines 34-62 and col 8, lines 55-66**), and a second magnification unit (**amplifiers 71R & 71B of Fig. 2 and 51R & 51B of Fig. 6**) that magnifies data of a second component signal of the color image signals (i.e. **amplifier 71 R or 51R of Figs. 2 & 6, respectively, processes R-signal of RGB components, col 5, lines 34-62 and col 8, lines 55-66**), and the magnified data of the first component signal magnified by the first magnification unit (i.e. **amplification data of G-signal of RGB components, Figs. 2 & 6, col 5, lines 34-62 and col 8, lines 55-66**).

Hirose does not disclose the second component signal being different from the first component signal, based on a ratio between the data of first component signal of the color image signals to be magnified by the first magnification unit and the data of the second component signal of the color image signals to be magnified by the second magnification unit.

Miyadera teaches the second component signal being different from the first component signal, based on a ratio between the data of first component signal of the

color image signals to be magnified by the first magnification unit and the data of the second component signal of the color image signals to be magnified by the second magnification unit (i.e. **the ratio of R/G and B/G are calculated such that “the ratios R/G and B/G are calculated based on the R, G, B signals, and white balance adjustment coefficients (amplification factors for the B and G signals) are obtained so that a proper white balance is obtained”**, col 4, lines 53-65).

Having an image processing apparatus of Hirose' 785 reference and then given the well-established teaching of Miyadera' 260 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image processing apparatus of Hirose' 785 reference to include that the second component signal being different from the first component signal, based on a ratio between the data of first component signal of the color image signals to be magnified by the first magnification unit and the data of the second component signal of the color image signals to be magnified by the second magnification unit as taught by Miyadera' 260 reference since doing so would increase the versatility of the image processing apparatus and enhance the accuracy of signal magnification, and further the disclosure provided could easily be established for one another with predictable results.

Regarding claim 21, in accordance with claim 20.

Hirose discloses wherein the predetermined color information includes a ratio of data of the plurality of color component signals (i.e. **first and second compression ratio**, col 3, lines 22-27).

Regarding claim 66, in accordance with claim 20.

Hirose discloses wherein the color image signals include a green (G) signal, a red (R) signal, and a blue (B) signal (i.e. **referring to Figs. 2 and 6, “means amplifying the Red (r), Green (G), and Blue (B) signals fed from the color image pickup device, col 3, lines 13-14**); the first component signal is the green signal (**referring to Figs. 2 and 6, G-signal is the first signal**); and the second component signal is either the red signal or the blue signal (**referring to Figs. 2 and 6, R-signal or B-signal is the second signal**).

Regarding claim 52.

Claim 52 is directed to a method claim which substantially corresponds to operation of the device in claim 20, with method steps directly corresponding to the function of device elements in claim 20. Thus, claim 52 is rejected as set forth above for claim 20.

Regarding claim 53, in accordance with claim 52.

Claim 53 is directed to a method claim which substantially corresponds to operation of the device in claim 21, with method steps directly corresponding to the function of device elements in claim 21. Thus, claim 53 is rejected as set forth above for claim 21.

Regarding claim 67, in accordance with claim 52.

Claim 67 is directed to a method claim which substantially corresponds to operation of the device in claim 66, with method steps directly corresponding to the function of device elements in claim 66. Thus, claim 67 is rejected as set forth above for claim 66.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on Monday to Friday, from 8:30 am -5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/
Examiner, Art Unit 2625
4/6/2009

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625